

REMARKS

The comments of the applicant below are each preceded by related comments of the examiner (in small, bold type).

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims, Therefore, the lubricators being sized respectively for use with conduit of different sizes must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim 29 has been canceled.

Claims 14-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,725,973. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variations of breadth and scope.

The applicant disagrees with the examiner's position. Without making any concession, the applicant will submit a terminal disclaimer to remove the rejection.

Claim 23 recites the limitation "the conduit" in line 5. There is insufficient antecedent basis for this limitation in the claim.

See line 2 of claim 23.

Claims 16, 28, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 16, 28, and 35, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Without conceding the examiner's position, the claims have been amended.

Claims 15-23, 34, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Heller (USPN 3,565,213).

Heller discloses a lubricator to apply lubricant to a strand (20) as it is pulled through a conduit, the lubricator including a coupling feature (14)

to mate with a corresponding coupling feature (corresponding threads) of a bushing;

the strand comprises an insulated electrical wire or the like; the coupling feature of the lubricator comprises threads; the threads comprise external threads;

the lubricator also includes a second coupling (15) feature configured to mate with a corresponding coupling feature of the conduit;

the second coupling feature of the lubricator comprises threads;

the threads comprise internal threads;

a body of the lubricator is formed of two connectable components (16, 11);

a lubricator to apply lubricant to a strand as it is pulled through a conduit, the lubricator including an external thread to mate with a corresponding internal thread (14) of a bushing, and an internal thread (15) to mate with a corresponding external thread (13) of the conduit.

The applicant disagrees. The elements marked 10 and 11 in figure 1 of Heller are “pipe sections” (column 2, line 30), not “bushings”. An advantage of a lubricator with a coupling feature to mate with a corresponding coupling feature of a bushing is that, in some cases, while the strand is being pulled, the same bushing that eventually will be mounted on the end of the conduit (once the pulling is done) may temporarily be mounted on the lubricator. No such advantage applies to the Heller lubricator. Heller intends for his pipe section to remain coupled to his lubricator after the pulling is done. Thus Heller did not describe and would not have made obvious the “coupling feature” of the lubricator recited in the applicant’s claim 15.

Claim 23 is patentable for at least the same reasons as claim 15 and also because Heller’s lubricator has only internal threads, not both an external thread and an internal thread.

Claims 34 and 35 have been canceled.

Claims 16 through 22 are patentable for at least the same reasons as claim 15.

Claims 24, 25 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Charlton (USPN 4,296,837).

Charlton discloses a lubricator to apply lubricant to a strand as it is pulled through a conduit, the lubricator comprising two body sections (18, 16) that can be connected to one another to form the lubricator, each of the body sections comprising a sleeve (20), the sleeves of the two body

sections being aligned when the two body sections are connected to form the body, and a pin (hinge pin through 20) that slides into the sleeves to hold the body sections together;

the lubricator includes an axis that is aligned along the length of the strand and the pin includes an axis that is parallel to the lubricator axis;

electrical wire.

Claim 24 has been amended to recite that the pin slides "removably into and out of the sleeves to hold the body sections together and to permit the body sections to be taken apart". Charlton teaches away from this arrangement. Charlton's split ring 14 has "half sections ... which are attached by a hinge 20, and a split adjustable sleeve 24, provided to releasibly attach the entry end lubricating assembly 6 to the entry end 8 of the conduit 4." In other words, in Charlton the function of the hinge 20 (which the examiner cites) to permanently connect the two half sections. It is Charlton's split adjustable sleeve 24 that is used to attach and remove the lubricating assembly. Charlton did not describe and would not have made obvious claim 24.

Claims 25 and 28 are patentable for at least the same reasons.

Claims 26, 27, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Charlton in view of Mefferd (USPN 5,269,572).

Charlton discloses all of the instantly claimed invention except a second pin and respective sleeves.

Mefferd discloses a second pin (104).

To modify the apparatus of Charlton so as to provide a second pin would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the teachings of Mefferd that such an arrangement improves the ability of the device to be quickly connected and disconnected.

Claims 26, 27, and 36 are patentable for at least the same reasons as claim 24.

Claims 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heller. Heller discloses the claimed invention, except for the lubricators being sized for use with conduit of different sizes. It would have been an obvious matter to change the size of the lubricators to accommodate different conduit, since such a modification would have

involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art.

Claims 29 through 33 have been canceled.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Charlton in view of Mefferd and Oetiker (USPN 4,693,502).

The Charlton and Mefferd combination (see above) show all of the instantly claimed invention except a seal.

Oetiker shows a seal (15).

To modify the reference combination above so as to provide a seal would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the teachings of Oetiker that such an arrangement improves the ability to contain flow, making the process more efficient.

Claim 37 is patentable for at least the same reasons as claim 24.

All of the dependent claims are patentable for at least the reasons for which the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

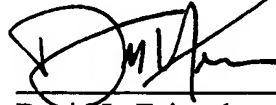
Applicant : Timothy L. Coder et al.
Serial No. : 10/717,752
Filed : November 19, 2003
Page : 12 of 12

Attorney's Docket No.: 16076-002002

Please apply any other charges or credits to deposit account 06-1050, reference 16076-002002.

Date: 3/29/5

Respectfully submitted,



David L. Feigenbaum
Reg. No. 30,378

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906
20959972.doc